IN THE

Supreme Court of the United States

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CHARLES ELMORE CROPLEY
CLERK

OCTOBER TERM, 1940.

No. 347

FOOD MACHINERY CORPORATION,

Petitioner,

vs.

FRUIT TREATING CORPORATION, WINTER PARK PACKING COMPANY, McDONALD CORPORATION, UMATILLA FRUIT COMPANY, and L. E. HOLLOWAY, TRADING AS L. E. HOLLOWAY & COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

FREDERICK S. LYON,
LEONARD S. LYON,
811 West Seventh Street Building,
Los Angeles, California,
O. K. REAVES,
Tampa, Fla.,
Counsel for Petitioner.

Parker & Baird Company, Law Printers, Los Angeles.

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Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT.

To: The Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, FOOD MACHINERY CORPORATION, respectfully prays for a Writ of Certiorari to the Circuit Court of Appeals for the Fifth Circuit to review a judgment of that Court entered May 27, 1940.*

*See Certified Copy at the end of the printed transcript of Record.

Summary and Short Statement of the Matter Involved.

This is a suit for infringement of a patent on a process of treating fruit. The patent, No. 1,909,860, was granted on May 16, 1933, to petitioner as assignee of the inventor, Dr. Rodney B. Harvey. The District Court for the Southern District of Florida found the patent valid, the patented process novel, and the first to provide a commercially successful method of enhancing the natural varietal color of the skin or peel of fresh citrus fruits by impregnating the latter to impart a uniform added color; that the patented process had utility and had gone into widespread commercial use, being employed on a large part of all of the oranges packed in the State of Florida, and had substantially increased the price at which said fruit was sold [*R. 673, Findings of Fact, 2, 3]. Judgment was entered accordingly for an injunction and recovery of profits and damages [R. 676-677].

The patented invention is the first discovery of a process by which the color of pale or yellow oranges may be enhanced to their true varietal orange-red color without injury to the fruit and without departing from the natural appearance of the fruit. Poorly colored oranges suffer a severe penalty when sold in competition with better colored oranges. A deficiency in color is no indication of any inferiority in the quality of the fruit and paler fruit may be as good or better than fruit of higher color. The Federal Department of Agriculture has for many years

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[*References to the printed transcript of record are herein referred to by the abbreviation "R." followed by the page number.]

encouraged and conducted experimental work to improve the appearance of citrus fruit. Approximately twenty years ago it introduced the ethylene bleaching process for removing any green chlorophyl that might otherwise mar the appearance of the fruit and most of the oranges produced in this country are treated by that process. The ethylene process will not deepen the color of pale fruit.

Owing to climatic or soil conditions most of the oranges produced in Florida and Texas are inferior in color compared with oranges produced in other localities and particularly California. After treatment with the ethylene process Florida and Texas oranges are a pale yellow compared to the more brilliant orange-red color of California oranges. In the markets the paler fruit is severely penalized because of its inferiority in color. The difficulties and penalties imposed on Florida and Texas oranges when sold in competition with higher colored fruit such as that from California has long been a matter of serious concern to the citrus producers of Florida and Texas. As the production of oranges increased in Florida the situation became acute and the color of Florida oranges was a matter of legislative and industry concern in Florida as early as the season of 1927-28. Prior to the introduction of the patented Color Added Process great difficulty was experienced in the marketing of Texas oranges in competition with the higher colored California oranges.

The process was introduced in Florida by appellee, Food Machinery Corporation, during the season of 1935-36 and this was followed shortly by the introduction of the process

in Texas. The process was immediately widely adopted by the citrus industries of both states and has since been used to enhance the color of most of the oranges marketed from those states. Substantially all of the packers of citrus fruit in the states of Florida and Texas are licensed by appellee and have acknowledged the validity of the patent in suit. Laws have been enacted by the legislatures of both the States of Florida and Texas to govern and regulate the use of the process and to prevent the process being abused by use on fruit of inferior quality. The process has served to substantially increase the returns from their orange crops to the citrus growers of the states of Florida and Texas. The patent in suit is the first to teach how to successfully apply an oil-soluble approved food dye to enhance their varietal color. This is something that had never been accomplished before Dr. Harvey's discovery.

Oranges are only produced in the Fifth and Ninth Circuits. The Harvey process is not used in the Ninth Circuit, as California and Arizona Oranges naturally have a bright orange-red varietal color. The process has been used in Florida and Texas in the Fifth Circuit. There is, therefore, substantially no chance that the process will ever go into use elsewhere than in the Fifth Circuit or that the validity of the Harvey patent will be adjudged in any other Circuit.

The defenses alleged in respondent's answer [R. 48-55] were the usual ones of want of invention, anticipation,

want of patentable novelty, prior invention by others, public use by others, and non-infringement.

The Court of Appeals, *sua sponte,* without even hearing argument on such defense, it not being mentioned in the briefs, and without any evidence on the question, declared the patent invalid, saying:—

> *"Since each of the three claims in question depends for its validity upon the sufficiency of the disclosures of the patent, the defect mentioned is the spoilation of all, and the bill of complaint should have been dismissed."* [Opinion C.C.A. found at end of printed record.]

No defense was alleged, as required under R.S.U.S. §4920—35 USCA §69 (*Providence Rubber Co. v. Goodyear Rubber Co.,* 76 U.S. 788; *Jennings v. Pierce,* Fed. Cas. 7283; *M. Swift & Son v. W. H. Coe Mfg. Co.,* 102 Fed. (2d) 391 at 393, C.C.A. 1; *Kansas City So. Ry. Co. v. Silica Products Co.,* 48 F. (2d) 503, at 507, C.C.A. 8), that the Harvey patent did not describe the process or method in such full, clear, concise and exact terms as to enable one skilled in the art to make and use the same (R.S.U.S. §4888; 35 USCA §33).

This issue was not litigated in the District Court and respondents offered no proof in an attempt to show any insufficiency of the Harvey specification to enable one skilled in the art to make and use the patented method.

The Harvey patent does not purport to cover the broad idea of dyeing oranges, or all processes of dyeing oranges. It was not so expanded or interpreted by the District Court, whose judgment extended no further than to sustain the patent and Claims 1, 3, and 4 thereof as valid as covering the particular process or method specifically set forth at page 3, lines 13-63 thereof [R. 425]. The Harvey patent describes more than one process or method, but this suit was predicated upon the infringement by respondents of the particular method so adjudged novel and infringed. It was not necessary for the District Court to determine whether the patent is valid if extended to any other method. Whether Harvey attempted to cover too much ground is a question that properly should be left until occasion arises for decision of that question. (*Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, at 432; *Faultless Rubber Co. v. Star Rubber Co.*, 202 F. 927, at 931, C.C.A. 6; *Research Products Co. v. Tretolite Co.*, 106 F. (2d) 530, at 534 (C.C.A. 9); *American Stainless Steel Co. v. Ludlum Steel Co.*, 290 F. 103 at 109, C.C.A. 2.)

Reasons Relied Upon for the Granting of a Writ of Certiorari.

The discretionary power of this Court is invoked upon the following grounds:–

1. Because of the concentration in the Fifth Circuit of the industry in which the patented method is used, litigation elsewhere resulting in conflict of decision is improbable. *Schriber-Schroth Co. v. Cleveland Trust Co., et al.,* 305 U.S. 47 at 50; *Mackay Radio & Telegraph Co., Inc. v. Radio Corp. of America,* 306 U.S. 86, at 89; *Paramount Publix Corp. v. American Tri-Ergon Corp.,* 294 U.S. 464; *Altoona Publix Theatres v. American Tri-Ergon Corp.,* 294 U.S. 477.

2. Because the decision of the Court of Appeals is in conflict with the decision of this Court in *The Providence Rubber Co. v. Goodyear,* 76 U.S. 788, and the decisions in *M. Swift & Sons v. W. H. Coe Mfg. Co.,* 102 Fed. (2d) 391, 393, C.C.A. 1; *Kansas City So. Ry. Co. v. Silica Products Co.,* 48 Fed. (2d) 503, 507, C.C.A. 8, and *Jennings v. Pierce,* Fed. Cas. 7283, holding that a defense of insufficiency of a patent specification is an affirmative defense raising an issue of fact, which must be pleaded, and with the decisions of this Court in *Battin v. Taggert,* 17 How. (58 U.S.) 77; *Wood v. Underhill,* 5 How. 1, 46 U.S. 1; *Webster Loom Co. v. Higgins,* 105 U.S. 580; *Hogg v. Emerson,* 52 U.S. 587; *Corn Planter Patent,* 23 Wall. 181; *Woodworth v. Wilson,* 4 How. 712, 716; *Lawler v. Hamilton,* 124 U.S. 1; *Minerals Separation v. Hyde,* 242 U.S. 261, 270, 271; *Eibel Process Co. v. Minnesota & Ont. P. Co.,* 261 U.S. 45, 65, that

even when properly pleaded such a defense presents an issue of fact to be determined on proofs; the grant of the patent is *prima facie* evidence of the sufficiency of the specification and a determination by the Patent Office authorities of this fact; the burden of proving otherwise is upon the defendant. *Chase v. Fillebrown,* 58 Fed. 374, 376.

WHEREFORE, Your Petitioner respectfully prays that a Writ of Certiorari be issued under the seal of this Court, directed to the United States Circuit Court of Appeals for the Fifth Circuit, commanding the said Court to certify and send to this Court on a day to be designated, a full and complete transcript of the record and all proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court, that the judgment of the Circuit Court of Appeals be reversed, and that Petitioner be granted such other and further relief as may seem proper.

FREDERICK S. LYON,
LEONARD S. LYON,
811 W. 7th St. Bldg., Los Angeles, Calif.,
O. K. REAVES,
Tampa, Fla.,
Counsel for Petitioner.

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Respondents.

BRIEF FOR PETITIONER.

Opinion:

The District Court filed no opinion. Its Findings of Fact and Conclusions of Law appear at R. 673 to 675. The opinion of the Circuit Court of Appeals is reported in 112 Fed. (2d) 119, and is reprinted at the end of the Transcript.

Jurisdiction:

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925. (43 Stat. 938; 28 USC 347).

Question Involved:

This is a patent suit involving only the usual defenses of want of invention, anticipation and non-infringement, all of which were determined in Petitioner's favor and a decree entered by the District Court sustaining the validity and infringement of the patent. No conflict of decision exists between the decision in this case and in any other Circuit Court of Appeals respecting the patentable novelty or scope of the instant Harvey invention. The Court of Appeals decided the case upon a defense raising an issue of fact not pleaded and not briefed or argued, *i.e.*,

> "When a patent is claimed for discovery, the law requires the patentee to state its component parts with clearness and precision, and to give a practical statement of its ingredients. When this burden is not met, or is met only vaguely and ambiguously, and it is apparent on the face of the specifications that no one could use the invention without first ascertaining by experiment the exact proportions of the different ingredients required to produce the result desired, it is the duty of the court to declare the patent void. In this case, the temperature variations, the shade or concentration of color desired, and the wide choice of ingredients, with their different powers and qualities, require a formula changing according to conditions. It is hardly conceivable that anyone, however skilled in the art, could obtain satisfactory results when dyeing oranges by the process patented without repeated experiments. Moreover, if from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent. *Wood v. Underhill,* 5 How. 1, 12 L. Ed. 23.

"The patentee, obviously in an effort to make his claims and specifications so all-inclusive that any process for the dyeing of oranges that might be devised would necessarily infringe his patent, not only has made them too broad to be included in the scope of the monopoly given by the patent laws, but he has failed sufficiently to particularize a definite formula or process, complete with ingredients and the proportions of their mixture, which is essential to a valid patent. Since each of the three claims in question depends for its validity upon the sufficiency of the disclosures of the patent, the defect mentioned is the spoilation of all, and the bill of complaint should have been dismissed.

The judgment of the district court is reversed, and the cause remanded for further proceedings not inconsistent with this opinion." (See Opinion Court of Appeals at end of printed record or p. 121 of 112 Fed.(2d).)

The use of the patented method is concentrated in the Fifth Circuit. Litigation elsewhere resulting in conflict of decision is improbable. Petitioner relies upon the rule of *Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 305 U.S. 47 at 50; *Mackay Radio & Telegraph Co. Inc. v. Radio Corp. of America*, 306 U.S. 86 at 89; *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U.S. 464; *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477.

Argument:

Respondents' answer does not, as required under R.S.U.S. 4920 (35 USCA §69) plead or give notice of any defense that the Harvey Patent in suit does not describe the process or method in such full, clear, concise

and exact terms as to enable one skilled in the art to make and use the same. (R.S.U.S. 4888, 35 USCA §33.)

In *The Providence Rubber Co. v. Goodyear,* 76 U.S. 788, this Court laid down the rule that: "The proposition that the patent is fatally defective, because it is impossible to make merchantable goods according to the directions, cannot be entertained. The answer contains no averment on the subject. No such issue was tendered to the complainants, and they have had no notice that such a defense was intended to be relied upon." See further *Jennings v. Pierce,* Fed. Cas. 7283; *M. Swift & Sons v. W. H. Coe Mfg. Co.,* 102 Fed. (2d) 391, 393, C.C.A. 1; *Kansas City So. Ry. Co. v. Silica Products Co.,* 48 Fed. (2d) 503, 507, C.C.A. 8.

This Court has repeatedly held that the defense that the patent specification is not "in such full, clear, concise, and exact terms as to enable any one skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same" (R.S.U.S. 4886) is an issue of fact and to be determined upon the evidence. *Battin v. Taggert,* 17 How. (58 U.S.) 77; *Wood v. Underhill,* 5 How. 1, 46 U.S. 1; *Webster Loom Co. v. Higgins,* 105 U.S. 580; *Hogg v. Emerson,* 52 U.S. 587; *Corn Planter Patent,* 23 Wall. 181; *Woodworth v. Wilson,* 4 How. 712, 716; *Lawler v. Hamilton,* 124 U.S. 1; *Expanded Metal Co. v. Bradford,* 214 U.S. 366; *General Fireproofing Co. v. Expanded Metal Co.,* 212 U.S. 577; *Minerals Separation v. Hyde,* 242 U.S. 261, 270, 271; *Eibel Process Co. v. Minnesota & Ont. P. Co.,* 261 U.S. 45, 65.

The grant of a patent is *prima facie* evidence of the sufficiency of the specification. It is a determination by

the Patent Office authorities of this fact and the *prima facie* validity of the patent prevails. The burden of proving otherwise is upon the defendant. *Chase v. Fillebrown,* 58 Fed. 374, 376.

The injection of this defense into the case by the Court of Appeals and its determination of the case thereon has foreclosed Petitioner from offering direct evidence of those skilled in the art as to the sufficiency of the specification. No proof was offered by the Respondents of any such insufficiency; no one skilled in the art testified that the specification was not so sufficient.

> "It is well settled that specifications of a patent are addressed to persons skilled in the art and a description sufficient to apprise them of the salient features of the invention is sufficiently definite. *Tilghman v. Proctor,* 102 U.S. 707, 26 L.Ed. 279; *Carnegie Steel Co. v. Cambria Iron Co.,* 185 U.S. 403, 22 S.Ct. 698, 46 L.Ed. 968."
>
> *Karesh v. Shell-on Sol-Ted P. Co.,* 17 Fed. (2d) 496, 500;
>
> *cf. Eibel Process Co. v. Minnesota & Ont. P. Co.,* 261 U.S. 45, 65.

The rule is that a specification is sufficient if a mechanic skilled in the art from the specification could use the invention. *Woodworth v. Wilson,* 4 How. 712, 716; *Lawler v. Hamilton,* 124 U.S. 1; *Minerals Separation v. Hyde,* 242 U.S. at 270-271; *Expanded Metal Co. v. Bradford,* 214 U.S. 366; *General Fireproof Co. v. Expanded Metal Co.,* 212 U.S. 577; *Corn Planter Patent,* 23 Wall. 181.

The Harvey Patent in suit covers the discovery of Dr. Rodney B. Harvey of the University of Minnesota of the well known Color Added Process, the use of which has greatly benefited the citrus producers of the States of Florida and Texas during the past five years. The patent does not purport to cover the broad idea of dyeing oranges or all processes of dyeing oranges. The patent was not so expanded or broadly interpreted by the District Court. The judgment of the District Court goes no farther than to sustain the patent to cover the particular process set forth in the patent at page 3, lines 13-63, R. 425.

The coloring of citrus fruit presents a problem which is unique in the dye industry. The peel or skin of an orange is composed of a combination of cellulose material and oil cells interlaid and coated with a natural wax. The natural color is accumulated just under the extremely thin waxy cuticle that is found on the exterior of the orange. A commercially successful process for enhancing the color of oranges must be one that will supplement the natural color by impregnating the skin or peel with additional dye to maintain the natural appearance of the fruit. A dye must be used which is approved by the Federal authorities as a non-poisonous food dye. Such dyes are soluble in oil but are not soluble in water. A formula must be provided which will permit a dye bath to be formed which can be readily applied to the fruit. The patent in suit describes more than one process by which this may be done.

The first of these processes is described at line 102, page 2 of the Harvey Patent [R. 424] and this process is not involved in this suit. This suit is limited to the question of validity of the Harvey Patent or the specific process or method described in the Harvey Patent, page 3,

lines 13-63, R. 425. The District Court found the patent valid as to this process and that this process was infringed by Respondents. [District Court's Findings of Fact and Conclusions, R. 673-675.] The dye bath of this process consists of from 90% to 99% of water. Since the dye will not dissolve in water, some additional substance is required to disperse the dye in the water. Soap is employed for this purpose. In addition to dispersing the dye the soap lowers the surface tension of the bath and acts to disintegrate the waxy coating of the fruit, thereby causing the dye to impregnate the peel or skin of the fruit. The soap dispersion of dye in the water is referred to in the patent in suit as an emulsion. This second process may for convenience be referred to as the aqueous soap process. A specific formula for this process is set forth in the patent (p. 3, lines 36-57) and reads as follows:—

> "Such emulsions may be prepared directly for use but preferably a stock emulsion is first made in concentrated form and then diluted with water. A suitable stock emulsion may contain from 50 to 250 parts of the color-imparting agents (solvent and coloring substances) and 25 to 250 parts of emulsifying agent and spreader such as soap, to 1000 parts of water by weight. Such stock emulsion in semi-liquid or paste form can then be diluted in the proportion of from about 1:50 to 1:200 with water or aqueous solution in the washing or treating tank. In other words, the final emulsion for imparting a desired color to fruit may contain from 0.5% to about 9.5% of solvent which carries a coloring substance and constitutes from about 0.01% to 1.0% by weight of the total and from about 90% to 99% of water, depending upon the quantity and character of the spreaders, emulsifying agents, and other materials present."

The judgment of the District Court was concerned solely with this second or aqueous soap process—"The process so commercially employed in the State of Florida is substantially the process disclosed in the patent in suit (page 3, lines 13-63) employing an aqueous dye bath containing soap and a colloidally suspended dye. Such process of enhancing the natural varietal color of fresh citrus fruit is not disclosed in any of the prior patents or printed publications relied upon by the defendants." [Finding No. 4, R. 673.] "There is no substantial difference between the accused process so employed by the defendants and the process described in the Letters Patent in suit (page 3, lines 13-63)". [Finding No. 13, R. 675.] The judgment was not concerned with the validity of the patent with respect to the first process in which no water or soap is present and only an oil or non-aqueous solvent is employed to carry the dye. This process is not in issue in this case.

There is no evidence in the record that any one skilled in the art was unable to successfully enhance the color of oranges by following the teachings and using the formula of the Harvey Patent, page 3, lines 13-63.

It is well settled law that in adjudicating the validity and infringement of a patent the Court need not go beyond the specific process in issue. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 432; *Faultless Rubber Co. v. Star Rubber Co.*, 202 F. 927, 931; *Research Products Co. v. Tretolite Co.*, 106 Fed. (2d) 530, 534 C.C.A. 9.

As said by the Circuit Court of Appeals for the Second Circuit in *American Stainless Steel Co. v. Ludlum Steel Co.*, 290 F. 103 at 109:

> "Whether there may not be in Haynes an attempt to cover too much ground is a question that may be left until occasion for decision arises."

In its opinion in this case the Court of Appeals refers to "the temperature variations, the shade or concentration of color desired, and the wide choice of ingredients, with their different powers and qualities, require a formula changing according to conditions.", and says: "It is hardly conceivable that any one, however skilled in the art, could obtain satisfactory results when dyeing oranges by the process patented without repeated experiments."

The patent is presumptively valid and sufficient. *Chase v. Fillebrown, supra.* The burden of proof is upon the Respondents. There is no evidence to sustain a Finding by the Court of Appeals that one skilled in the art would have any unusual difficulty in any of these particulars. For example, Respondents called as a witness Dr. James Otis Handy, a graduate in chemistry of Massachusetts Institute of Technology. [R. 255.] In testifying with respect to the dye art Dr. Handy testifies [R. 269]:

> "Q. Now again, this matter of temperatures. Why do you use temperatures in chemical reactions generally. Do they have any effect on the speed of the operation?
>
> A. They do. The raising of temperature, as far as I know, always increases the speed of reaction; on the other hand, there are certain low temperature reactions where you must keep things cool or you do not get the results you want; but generally you accelerate reactions by heat.
>
> Q. Would you consider it within the skill of an ordinary mechanic to adjust the temperature of a solution to fit the material being treated in that solution?
>
> A. I do. I think it is a rather obvious method of investigation."

This testimony was given with reference to a prior art Hathorne Patent, Exhibit No. 15, but shows that those skilled in the art, contrary to the opinion of the Court of Appeals, would have no difficulty whatsoever with the temperature variations and would not require experimentation to the degree required to bring a given description under the rule of insufficiency upon which the Court of Appeals grounded its decision.

Respondents also called as a witness Dr. W. H. Beisler, head of the Department of Chemical Engineering at the University of Florida [R. 204] and asked him to "explain to the Court the disclosure of that patent" (the Harvey Patent in suit) [R. 205]. Dr. Beisler explains the two methods disclosed therein [R. 205-209] and testifies that he has made up an emulsion "according to the description of the second technique (method) in the Harvey patent" [R. 208-9]. That he has dyed oranges with such emulsion [R. 209]. It is significant that Dr. Beisler does not assert or refer to any ambiguity or insufficiency in the patent description, p. 3, lines 13-63, or to any necessity for experimenting. It is to be expected that the chemist will use the routine skill of his calling.

But the mere fact that one skilled in the art might be required to try the usual test experiments in order to determine exact proportions, temperatures, etc., is not sufficient to establish the legal objection of insufficiency of description. This is made clear by the decisions of this court in *Minerals Separation v. Hyde, supra,* 242 U.S. at

270-71; *Eibel Process Co. v. Minnesota & O. P. Co., supra,* 261 U.S. at 65; *Lawther v. Hamilton,* 124 U.S 1; *cf. Vortex Mfg. Co. v. Ply-Rite Cont. Co.,* 33 F. (2d) 302 at 308-9; *Wenborne-Karpen Dryer Co. v. Cutler Kiln Co.,* 285 F. at 75; *General Bakelite Co. v. General Ins. Co.,* 276 F. at 184; *Toledo Rex Spray Co. v. California Spray Chem. Co.,* 268 F. at 204, 205.

We respectfully submit that this case is one in which the discretionary power of this Court should be exercised by the writ of certiorari to the end that the case be decided in accordance with established principles of law.

Respectfully submitted,

FREDERICK S. LYON,
LEONARD S. LYON,
811 W. 7th St. Bldg., Los Angeles, Calif.,

O. K. REAVES,
Tampa, Fla.,

Counsel for Petitioner.

Office - Supreme Court, U. S.
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CHARLES ELMORE CROPLEY
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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

ALBERT M. AUSTIN,
FURMAN RINEHART,
120 Broadway,
New York City,

JOHN B. SUTTON,
G. L. REEVES,
Tampa, Florida,
Counsel for Respondents.

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In the

Supreme Court of the United States

OCTOBER TERM, 1940

No. 347

Food Machinery Corporation,
Petitioner,

vs.

Fruit Treating Corporation, Winter Park Packing Company, McDonald Corporation, Umatilla Fruit Company, and L. E. Holloway, Trading as L. E. Holloway & Company,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

This is an ordinary patent case in which the defendants, respondents here, relied upon the usual defenses of invalidity and non-infringement. The Circuit Court of Appeals decided both of these issues in favor of respondents.

There is no conflict of decisions between courts in different circuits, nor does the petition set forth any novel questions to be decided, for indeed, there are none.

The Harvey patent in suit, granted May 16, 1933, No. 1,909,860, relates to the dyeing of citrus fruit including oranges. Briefly, the process of dyeing oranges consists in immersing the oranges in a bath containing the dye at

a temperature and for a period sufficient to obtain the desired color just as a garment or other cloth might be dyed.

The case was heard in the first instance before the District Court for the Southern District of Florida, Judge Alexander Akerman, who decided the case at the close of the trial without receiving written briefs. No written opinion was handed down by the District Court.

Upon the whole record, which was before it, the Court of Appeals passed upon the questions of validity and of infringement and stated (112 F. (2d), 119; R. 685):

> "The record contains abundant evidence relating to the questions of whether the invention was anticipated in the prior art and hence not subject to patent, and whether the coloring process used by appellants infringed the patent. The prior-art attack appears meritorious, and we are also of the opinion that there was no infringement; but we prefer to rest our decision upon other grounds which render further discussion of these questions unnecessary."

It is clear, therefore, that the Court below held the prior art relied upon by respondents was sufficient to invalidate the claims of the patent before it and that respondents' way of dyeing oranges did not infringe the patent, either of which holdings must result in dismissal of the bill of complaint.

But confronted with a patent[1] so broad and comprehensive in description and with claims so nebulous, ambiguous, and "all-inclusive" as to be capable of being read to encompass any and all methods of dyeing any and all citrus fruit in a liquid dye bath, the Court, *sua sponte*, pointed out a further reason for dismissing the bill of complaint, in addition to the two above mentioned.

It is solely to this latter branch of the case that the petition for writ of certiorari is directed since the holdings of the Court of Appeals with respect to the prior art and non-infringement are disregarded.

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[1] The Harvey patent in suit is reproduced page 423 of the record.

Petitioner advances two reasons for the grant of the petition which may be summarily stated and answered as follows:

Reason 1.

Although ambiguous in statement this point in substance is based upon the proposition that the practice of dyeing citrus fruit is concentrated in the Fifth Circuit and that this Court should therefore review the case.

The "industry in which the patented method is used" is the citrus industry but the largest producer of citrus fruit is the State of California in the Ninth Circuit.

Although the dyeing of citrus fruit is carried on extensively in Florida and to a lesser extent in Texas, it does not follow that dyeing of citrus fruit is practiced in no other areas. As a matter of fact, the petitioner itself has carried on the practice in California at least experimentally (R. 176) and others have dyed fruit there (R. 300, 325, 333). Moreover, any process directed to enhancing the external appearance of citrus fruit is likely to be used wherever the fruit is grown.

While the concentration of an industry, such as the manufacture of automobiles which are in wide and almost universal use, may be one reason for granting certiorari (*Schriber-Schroth Co.* v. *Cleveland Trust Co. et al.*, 305 U. S. 47, 50), this Court has not indicated that such a fact is of general or compelling significance.

Reason 2.

This point as expressed in the petition is that the Court of Appeals has decided the case upon the grounds of insufficiency of disclosure of the patent specification which petitioner contends is a matter for affirmative defense raising an issue of fact.

There is, we submit, no substance in this point.

(1) The Court of Appeals, on the entire record, as pointed out above, held that the prior art attack upon the validity of the patent was meritorius and further that there

was no infringement. Either of these holdings must result in a direction to dismiss the bill of complaint.

(2) The Court of Appeals has said in effect that this patent, as a matter of law, when considered on its face is so comprehensive and general in description and so nebulous, ambiguous and "all-inclusive" with respect to its claims that the patentee has not met the burden placed upon him by the patent statutes.

The Court of Appeals has set forth in its opinion ample authority to sustain what it has held. It has seen fit to point out an additional reason warranting dismissal of the bill of complaint.

It is a settled rule of this Court that if the patent is invalid on its face the Court may stop short at the instrument and dismiss the bill (*Brown* v. *Piper*, 91 U. S. 37, 44) even when the question of validity is not raised by the pleadings (*Slawson* v. *Grand Street R. R. Co.*, 107 U. S. 649).

In *Brown* v. *Piper, supra,* this Court considered the patent before it in the light of the record and held it to be anticipated by prior art in evidence. The Court thereupon proceeded in its opinion by saying (p. 41, near bottom): "There is another view of the case that may properly be taken." And then the Court discussed the patented method in view of the well known ice cream freezer which had not been considered by the lower court. That case has long since become classic not only in patent law but in the general law as well. The opinion of this Court concludes:

> "Examined by the light of these considerations, we think this patent was void on its face, and that the court might have stopped short at that instrument, and without looking beyond it into the answers and testimony, *sua sponte*, if the objection were not taken by counsel, well have adjudged in favor of the defendant."

In the instant case the Circuit Court of Appeals followed the procedure thus succinctly approved by this Court. In

addition to the reasons previously given with respect to the prior art and non-infringement based upon the record, the Court, upon consideration of the patent itself, *sua sponte*, found it did not comply with the requirements of the patent statutes.

Finally, we call this Court's attention to *Permutit Co.* v. *Graver Corporation*, 284 U. S. 52, cited by the Court below in its opinion, and particularly to page 60 where this Court said:

> "The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, *but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.*" (Italics ours.)

See also, *General Electric Co.* v. *Wabash Appliance Corp. et al.*, 304 U. S. 364, 369.

The Harvey patent in issue has not met the test laid down by this Court, as the Circuit Court of Appeals has said and as a perusal of it will show.

We submit that no grounds have been presented which justify a review of the case by this Court. The petition for writ of certiorari should be denied.

Respectfully submitted,

ALBERT M. AUSTIN,
FURMAN RINEHART,
120 Broadway,
New York City,

JOHN B. SUTTON,
G. L. REEVES,
Tampa, Florida,

Counsel for Respondents.